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Paper No. 9
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Times Mirror Magazines, Inc.

Serial No. 75/467,099

Avis Frazier-Thomas for Times Mirror Magazines, Inc.

Hannah M. Fisher, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney).

Before Hanak, Bucher and Holtzman, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Times Mirror Magazines, Inc., a corporation of New York, has filed an application to register the mark "THE SPORTING NEWS FANTASY FOOTBALL CHALLENGE," for goods described as "role playing games, namely, providing sports fans with a format wherein they are able to draft individual professional players from the field of football and compete with these selected individuals in fictitious playoff and championship games," in International Class 28.¹

¹ Serial No. 75/467,099 filed on April 13, 1998, based upon applicant's claim of use in interstate commerce since January 31, 1993. On January 28, 1999, applicant amended the application to seek registration of this matter under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f). At that point, the Trademark

The Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to role playing games, so resembles the mark, "FANTASY FOOTBALL," (with the word "Football" disclaimed), registered for "entertainment services -- namely, conducting a mock football game," as to be likely to cause confusion, to cause mistake, or to deceive.²

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Trademark Examining Attorney filed briefs. Applicant did not request a hearing.

We reverse the refusal to register.

The Trademark Examining Attorney argues that "... the endeavors of both parties are likely to appeal to the same group of consumers, football fans." In spite of overall differences between the marks, the Trademark Examining Attorney takes the position that applicant has "... improperly attempted to appropriate registrant's mark."

Examining Attorney's initial requirement for a disclaimer of the words "sporting" and "fantasy football challenge" was withdrawn.
² Registration No. 1,335,992, issued to Midwest Television, Inc. on May 14, 1985, based on a claim of use in commerce since September 21, 1982; §8 affidavit accepted and §15 affidavit received.

By contrast, applicant argues that its mark, "THE SPORTING NEWS FANTASY FOOTBALL CHALLENGE," is substantially different from the trademark "FANTASY FOOTBALL" as to appearance and sound, and that its marks, which includes its previously registered house mark, conveys a significantly different commercial impression than does the cited mark. Applicant argues that given the extreme weakness of "FANTASY FOOTBALL," the cumulative difference in the goods and services combined with the obvious differences in the marks, will negate any likelihood that their contemporaneous use will result in consumer confusion.

Our resolution of the issue of likelihood of confusion under Section 2(d) of the Act is based upon an analysis of all the probative facts and evidence that are relevant to the factors identified as bearing on the issue of likelihood of confusion. See In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn our attention first to the relationship between the goods as identified in the instant application and the services as recited in the registration. As demonstrated by evidence placed in the record by the Trademark Examining Attorney, in this Internet age, "fantasy football" has become a popular and sophisticated gaming past time for many -- exactly the type of role-playing game described in some detail in applicant's identification of goods. The record demonstrates that applicant is just one of many organizations offering "fantasy football" through online sites.

On the other hand, registrant's services, recited as "entertainment services -- namely, conducting a mock football game," appear to us to be a bit vague, and so we are not confident that we know exactly the nature of the entertainment services recited in the registration. Although registrant is a television station, we cannot narrow the services in any manner based upon this fact alone. Accordingly, in attempting to ascertain how closely related are registrant's services to applicant's goods, we can only speculate that "mock football" services and "fantasy football" games do appear to be related in some fashion. By the same token, they are not identical, inasmuch as there appear to be differences between

registrant's recited services and the role-playing games offered by applicant.

We turn next to the similarities and dissimilarities between the respective marks. Applicant concedes, as it must, that its mark contains registrant's mark in its entirety. While the Trademark Examining Attorney argues that is the end of the inquiry, we agree with applicant that there exist exceptions to this general rule cited by the Trademark Examining Attorney.

The evidence in the file demonstrates that the term "fantasy football" is descriptive of applicant's goods. Applicant argues that this matter must also be deemed descriptive of registrant's services. However, in light of the fact that the cited mark is the subject of an incontestable registration, we conclude that as this combined term is understood today, it must be deemed highly suggestive of registrant's entertainment services. Accordingly, to the extent that the cited trademark is a relatively weak mark entitled to a narrow scope of protection, the addition of applicant's house mark should be sufficient to preclude likelihood of confusion. See MarCon Ltd. v Avon Products Inc., 4 USPQ2d 1474, 1476 (TTAB 1987) [applicant's addition of its house mark "AVON" to suggestive term "SILKEN" is sufficient to distinguish its

"AVON SILKEN SOAP" from opposer's "SILK" for hair and skin care products].

Decision: The refusal to register under Section 2(d) of the Act is reversed.

E. W. Hanak

D. E. Bucher

T. E. Holtzman

Administrative Trademark
Judges, Trademark Trial
and Appeal Board